

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

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UNITED STATES OF AMERICA,

CASE NO. CR. 03-0095 WBS

Plaintiff,

v.

ORDER RE: DEFENDANTS'  
MOTION TO DISMISS COUNTS 1-4  
AND 10-19

AMR MOHSEN and ALY MOHSEN,

Defendants.

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Defendants Amr and Aly Mohsen are charged jointly in Count One of the Superseding Indictment with conspiracy to obstruct justice and to commit perjury in violation of 18 U.S.C. § 371, and in Count Nineteen with obstruction of justice in violation of 18 U.S.C. §§ 1503 and 2. Defendant Amr Mohsen is also charged separately in Counts Two through Four with perjury in violation of 18 U.S.C. § 1621(1); in Count Ten with subornation of perjury in violation of 18 U.S.C. § 1622; and in Counts Eleven through Eighteen with mail fraud in violation of 18 U.S.C. § 1341 and 2. Id. Defendant Amr Mohsen moves to dismiss Counts One through Four and Counts Ten through Nineteen. Amr

1 Mohsen's co-defendant Aly Mohsen joins in this motion with  
2 respect to Counts One and Nineteen.

3 I. Factual and Procedural Background

4 The following is taken from Aptix v. QuickTurn, No. 98-  
5 00762, 2000 WL 852813 (N.D. Cal. June 14, 2000) and Aptix v.  
6 QuickTurn, 269 F.3d 1369 (Fed. Cir. 2001), except where otherwise  
7 indicated by citation. On September 20, 1989, Aptix Corporation  
8 (hereinafter "Aptix") filed patent number 5,544,069 (hereinafter  
9 "'069 patent"). The '069 patent was issued by the United States  
10 Patent and Trademark Office on August 6, 1996. It claims the  
11 invention of general purpose "field programmable" circuit boards  
12 that computer programmers can use to reconfigure the electronic  
13 components of an integrated circuit.

14 On February 26, 1998, Aptix sued QuickTurn Design  
15 Systems (hereinafter "QuickTurn") for infringement of its '069  
16 patent. The Local Civil Rules in this district required Aptix to  
17 disclose the claims it would assert and the corresponding dates  
18 on which those claims were invented. Aptix disclosed that it  
19 would assert four claims (4, 5, 7, and 8) on April 13, 1998, but  
20 stated that it was unable to provide the dates of conception  
21 because the inventor, Amr Mohsen, was out of the country at that  
22 time. Included in the initial disclosures were seventeen pages  
23 from the "1989 Notebook", and these pages contained information  
24 about "research, design, and development" of the invention.<sup>1</sup>

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26 <sup>1</sup> Proving a conception date earlier than the date the patent  
27 was filed is important for preventing articles and other  
28 inventions from being considered "prior" art that can invalidate  
the patent by rendering it obvious or anticipated. See Am.  
Standard v. Pfizer, 722 F. Supp. 86 (D. Del. 1989). "In order to

1 Between April and December of 1988, Amr and Aly Mohsen  
2 allegedly engaged in a series of actions that are the basis for  
3 the charges at issue in this motion. Amr Mohsen claimed that he  
4 had found another engineering notebook that was allegedly started  
5 in 1988 and that contained evidence of an earliest date of  
6 conception. On May 4, 1998, based on the 1988 notebook, Aptix's  
7 lawyer served a disclosure that listed the date of conception for  
8 all the claims as July 31, 1988 (approximately one year earlier  
9 than the filing date).

10 During discovery, many of the parties' disputes  
11 centered around the notebooks. On June 4, 1998, defendant Amr  
12 Mohsen brought the 1988 and 1989 notebooks to his deposition as  
13 evidence of his research and development that led to the '069  
14 patent. Aptix only provided QuickTurn with copies of these  
15 notebooks. Quickturn moved for production of the originals of  
16 the notebooks on November 24, 1998. Shortly thereafter, Amr  
17 Mohsen reported that the original notebooks had been stolen from  
18 his car.

19 On December 8, 1998, in an opposition to a motion by  
20 QuickTurn, Aptix stated, "These notebooks . . . represent crucial  
21 evidence for Aptix regarding the date of conception of Dr.  
22 Mohsen's invention and diligence in reducing the invention to  
23 practice. Dr. Mohsen's first notebook is likely to be  
24 particularly important to Aptix's prosecution of this case

25 \_\_\_\_\_  
26 receive an effective date earlier than the filing date of [a  
27 patent] for the purpose of determining whether a reference is  
28 prior art, a patentee has the burden of proving by clear and  
unequivocal evidence, that the invention was both conceived and  
reduced to practice before the application date." Id. at 109.

1 because the contents support Aptix's position that Dr. Mohsen  
2 conceived his invention before the date of any of the alleged  
3 prior art offered by QuickTurn." Aptix, 2000 WL 852813 at \*22.

4 Approximately one year later, on December 6, 1999,  
5 Judge Alsup held an evidentiary hearing at which he examined  
6 evidence, assessed the credibility of witnesses, and determined  
7 the authenticity of the notebooks. Amr Mohsen took the stand at  
8 this hearing but asserted his Fifth Amendment right and did not  
9 answer any questions. Following that hearing, Judge Alsup found  
10 that Amr Mohsen made additions in the form of text and diagrams  
11 to the 1989 notebook after the dates listed on the pages and  
12 attempted to pass those changes off as originals. Amr Mohsen was  
13 also found to have falsely backdated entries in the notebook to  
14 August 6, 1989. Moreover, the entire 1988 notebook was found to  
15 be a fraud.<sup>2</sup>

16 Approximately two months later, Judge Alsup held a two-  
17 day Markman hearing to interpret and construe the claims of the  
18 patent. (Markman Hr'g Tr. 303, Feb. 2, 2000.) On February 29,  
19 the final ruling on claim construction was issued by the court.  
20 (Markman Hr'g Tr. 352, Feb. 29, 2000.) In that ruling, the court  
21 construed the principal claim in the suit, claim 4, and discussed  
22 dependent claims. (Defs.' Mot. to Dismiss Counts 1-4 and 10-19  
23 Ex. G at 4.) The court described the invention disclosed as  
24 follows: "a handy one-piece board containing all electronic  
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26 <sup>2</sup> Within the 1988 notebook, Amr Mohsen created entries with  
27 respect to programmability, a central feature of the '069 patent.  
28 Amr Mohsen also fabricated information about "one or more  
substrates," relating to the use of multiple boards in the  
invention, which was a contested issue in the patent case.

1 components and first-level PIC's [or programmable integrated  
2 circuits]." (Id. at 7.) Only certain terms were in dispute.  
3 The court found that multiple boards were contemplated by the  
4 invention, but that the important components would have to be  
5 present on the same substrate, contrary to QuickTurn's  
6 contentions. (Id. at 6.) The court construed the term  
7 "substrate" to include "a printed circuit board (and/or a layer  
8 of printed circuit board)." (Id. at 5.) The court also  
9 construed the terms "electronic components" to include connectors  
10 capable of receiving electronic components, although QuickTurn  
11 argued otherwise. (Id. at 7.) The court construed "component  
12 contacts" to mean types of contacts found in the substrate(s) to  
13 which a user can selectively attach electronic components. (Id.)  
14 The court found that the term group means "two or more," and not  
15 "three or more," as Aptix argued. The court also held, contrary  
16 to the plaintiff's contention for a narrower construction, that  
17 "each second-level PIC is connected to at least two but not  
18 necessarily all of the first-level PIC's. (Id. at 8, 11.) Thus,  
19 some of the court's findings favored the plaintiff and others  
20 favored the defendant.

21         On April 3, 2000, QuickTurn filed a submission that  
22 relied on two claims of prior art to invalidate the '069 patent  
23 for obviousness. (Defs.' Mot. Dismiss 5.) QuickTurn had  
24 previously made other claims of prior art, but refrained from  
25 asserting them in this filing. (Id. n.1) One claim was based a  
26 combination of references: the "Butts engineering notebook" dated  
27 June 3, 1988, a related patent application, an article published  
28 in January 1975, and a report from 1971. (Defs.' Mot. Dismiss

1 Ex. A at 5.) Based on this prior art claim, Mohsen's date of  
2 invention needed to predate June 3, 1988. The other claim set an  
3 even earlier date, based on the 1965 "Spandorfer Report" in  
4 combination with other references. (Id. at 6.) Neither the  
5 district court nor the Federal Circuit conclusively decided  
6 whether either of these prior art references anticipated the '069  
7 patent or rendered it obvious.

8 Also on April 3, 2000, Aptix filed a Fourth Amended  
9 Initial Disclosure of Asserted Claims in which it asserted that  
10 the effective filing date of the patent (September 20, 1989) as  
11 the earliest date of invention, instead of the date in Mohsen's  
12 notebook (July 31, 1988). (Defs.' Mot. Dismiss Ex. A at 2.)  
13 This disclosure was filed after Judge Alsup's factual findings  
14 about falsified information in the notebooks.

15 On June 14, 2000, Judge Alsup dismissed Aptix's  
16 complaint on the basis of Aptix's unclean hands in falsifying  
17 information in the notebooks, and found the case to be  
18 exceptional such that Aptix was required to pay attorney's fees  
19 and costs. He further found the patent to be unenforceable. The  
20 Federal Circuit upheld dismissal of the suit and award of fees  
21 and costs, but vacated the finding of unenforceability of the  
22 patent.

23 Defendants now move to dismiss Counts One through Four  
24 and Ten through Nineteen of the indictment, contending that "the  
25 government will not be able to prove that the alleged perjuries  
26 were material to the civil patent litigation because, as a matter  
27 of law, the 1988 notebook was not relevant to the civil patent  
28 case." (Defs.' Mot. to Dismiss 4 (emphasis in original).)

1 II. Discussion

2 Under Federal Rule of Criminal Procedure 12(b)(2), "[a]  
3 party may raise by pretrial motion any defense, objection, or  
4 request that the court can determine without a trial of general  
5 issue." The Ninth Circuit has applied the Rule 12 standard to  
6 hold that "a motion to dismiss is generally 'capable of  
7 determination' before trial 'if it involves questions of law  
8 rather than fact.'" United States v. Nukida, 8 F.3d 665, 669 (9th  
9 Cir. 1993), quoting United States v. Shortt Accountancy Corp.,  
10 785 F.2d 1448, 1452 (9th Cir. 1986) (overturning district court's  
11 grant of a motion to dismiss based on the finding that Nukida's  
12 actions did not affect commerce. The motion to dismiss required  
13 factual determinations and thus was a premature challenge to the  
14 sufficiency of the government's evidence.); see also United  
15 States v. Boren, 278 F.3d 911, 914 (9th Cir. 2002).

16 It is fundamental that Rule 12(b) may not be used to  
17 challenge the sufficiency of the evidence supporting an  
18 indictment. United States v. Jensen, 93 F.3d 667, 669 (9th Cir.  
19 1995). In Jensen, the Ninth Circuit found that "[a] defendant  
20 may not properly challenge an indictment, sufficient on its face,  
21 on the ground that the allegations are not supported by adequate  
22 evidence." Id. (quoting United States v. Mann, 517 F.2d 259, 267  
23 (5th Cir. 1975)). The court further noted that "[a] motion to  
24 dismiss the indictment cannot be used as a device for a summary  
25 trial of the evidence . . . . The Court should not consider  
26 evidence not appearing on the face of the indictment." Id.  
27 (quoting United States v. Marra, 481 F.2d 1196, 1199-1200 (6th  
28 Cir. 1973)); accord, United States v. Alonso, 143 F.3d 772, 776-

1 77 (2d Cir. 1998) ("Unless the government has made what can fairly  
2 be described as a full proffer of the evidence it intends to  
3 present at trial to satisfy the jurisdictional element of the  
4 offense, the sufficiency of the evidence is not appropriately  
5 addressed on a pretrial motion to dismiss an indictment.").

6 Where materiality is an element of a crime, it is  
7 generally a mixed question of law and fact for the jury to  
8 decide. *United States v. Gaudin*, 515 U.S. 506, 511 (holding that  
9 materiality of a perjured statement was an issue for the jury).

10 In *Gaudin*, the Court explained that "the  
11 application-of-legal-standard-to-fact sort of question posed by  
12 [the issue of whether a statement was material], commonly called  
13 a 'mixed question of law and fact,' has typically been resolved  
14 by juries." The Ninth Circuit has applied this standard in cases  
15 where materiality is an element of the crimes charged. *United*  
16 *States v. Keys*, 133 F.3d 1282, 1286 (9th Cir. 1998) (explicitly  
17 overruling a previous holding and jury instruction that assumed  
18 materiality was a matter of law for the judge to decide); see  
19 also *United States v. Knapp*, 120 F.3d 928 (9th Cir. 1997) ("the  
20 Supreme Court's reasoning [in *Gaudin*] applies with equal potency  
21 to every crime of which materiality is an element." (quoting  
22 *United States v. Uchimura*, 12 F.3d 1282, (9th Cir. 1997))).

23 Defendants in this case contend that the 1988 notebook  
24 and Amr Mohsen's testimony concerning the notebook were  
25 immaterial to the patent dispute between Aptix and Quickturn as a  
26 matter of law because the definitions given to claim elements in  
27 Judge Alsup's construction of the claims rendered the prior art  
28 QuickTurn cited that post-dated the notebook legally irrelevant.



1 Moreover, because the 1988 notebook set a date of invention that  
2 was earlier than the filing date, but not early enough to defeat  
3 the prior art QuickTurn ultimately relied on, defendants argue  
4 that Mohsen's fabrication could not help him win the race to  
5 invent.<sup>3</sup>

6 A statement is material if it has "a natural tendency  
7 to influence, or [be] capable of influencing, the decision of the  
8 decisionmaking body to which it was addressed." Kungys, 485 U.S.  
9 at 770; see also Gaudin, 515 U.S. at 509. In addition, "[t]o be  
10 material a false statement need only be 'relevant to any  
11 subsidiary issue under consideration.'" United States v. Lococo,  
12 450 F.2d 1196, 1199 (9th Cir. 1971). Significantly, materiality  
13 is tested at the time of the false statement or mailing. United  
14 States v. McKenna, 327 F.3d 830, 839 (9th Cir. 2003).<sup>4</sup>

15 Thus, the timing of the acts forming the basis for  
16 defendants' alleged perjury and mail fraud informs a decision on  
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18 <sup>3</sup> Defendants argue that the reason QuickTurn's counsel  
19 withdrew pieces of prior art that postdated the notebook was that  
20 they were irrelevant, and that QuickTurn relied on two pieces of  
21 prior art predating the July 31, 1988 date in the notebook  
22 because this prior art conclusively established that Aptix's  
23 invention was invalid for being obvious. This argument rests  
24 only on defendants' own suspicions about the motivations of  
25 QuickTurn's counsel. Counsel's decisions may have been motivated  
26 by other considerations altogether. For example, QuickTurn's  
27 counsel may have decided to rely on fewer pieces of prior art so  
28 as not to confuse the jury and picked the earliest pieces of  
prior art available. Alternatively, QuickTurn's counsel may have  
chosen the scientific texts that were easiest for laypeople to  
interpret.

<sup>4</sup> Defendants argue that the government's reliance on  
26 McKenna is unfounded because McKenna is inapposite. Although  
27 McKenna is distinguishable because it addresses the situation in  
28 which a defendant testified at trial and therefore put her  
credibility at issue, 327 F.3d at 839, it is helpful for the  
guidance it provides regarding the legal standards for perjury.

1 materiality. Defendants' alleged actions forming the basis of  
2 the counts that are the subject of this motion were conducted  
3 between April and December of 1988, and therefore were completed  
4 approximately one year before the Markman hearing held by Judge  
5 Alsup. In addition, these actions took place more than a year  
6 before QuickTurn's supplemental submission that the defendants  
7 claim rendered the notebooks irrelevant. Therefore, defendant's  
8 argument that the 1988 notebook was immaterial rests upon events  
9 that occurred much later in the course of the underlying  
10 proceedings. At the time defendants undertook these acts and  
11 created a notebook falsifying the date of conception, when the  
12 invention was conceived was an open and important question. As  
13 Judge Alsup expressed:

14           In the early stages of patent litigation,  
15           before the landscape of the relevant prior art  
16           is fully illuminated, a patent owner cannot  
17           usually predict the exact combinations of art  
18           that might later be deemed to render a patent  
19           obvious or anticipated. Experience teaches,  
          however, that any date of invention prior to  
          the presumed date of invention (the date of  
          the patent application) will ordinarily place  
          the patent owner in a stronger position by  
          rendering any intervening art immaterial.

20 Aptix, 2000 WL 852813 at \*25. At the time it was introduced, the  
21 evidence in the inventor's notebooks establishing an earlier date  
22 of invention would therefore have a natural tendency to influence  
23 the trier of fact in determining an important issue in the case -  
24 the date the invention was conceived.<sup>5</sup>

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26           <sup>5</sup> By introducing a date of conception that was more than a  
27 year earlier than the date the patent was filed, Aptix was able  
28 to foreclose the entire universe of prior art published after  
that date. It is unclear whether there were other pieces of  
prior art that would have been relevant but were not introduced

1 Amr Mohsen is alleged to have fabricated information  
2 related to the content of the invention in both the 1988 and 1989  
3 notebooks, including the types of substrates used and the  
4 programmability of the invention. Programmability was an  
5 important issue in the case. The meaning of the term "substrate"  
6 was also in dispute and was later construed in the Markman  
7 hearing. (Defs.' Mot. to Dismiss Counts 1-4 and 10-19 Ex. G at  
8 6.) This information from the notebooks about claim elements  
9 could have been very material to the case at the time the  
10 testimony and notebooks were presented, because information from  
11 the notebooks could have served as extrinsic evidence to help  
12 resolve ambiguity and further the court's understanding of the  
13 patent. See Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576,  
14 1583-84 (Fed. Cir. 1996).

15 Finally, defendants argue that materiality cannot be  
16 established because Judge Alsup "did not make [a] finding that  
17 the Mohsen 1988 notebook would ever be a matter to be considered  
18 by the ultimate fact-finder in the civil patent suit." (Defs.  
19 Mot. Dismiss at 15.) Judge Alsup made no such finding because  
20 the evidence falsified in the notebooks demonstrated defendants'  
21 unclean hands, and therefore required dismissal of the case.  
22 Contrary to defendants' argument, it seems unlikely that Aptix  
23 would be dismissed from suit, and that the dismissal would be  
24 affirmed by the Federal Circuit, for falsifying information that  
25 was immaterial to the patent case. The doctrine of unclean hands

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27 because of the introduction of the notebook, but considering such  
28 a question would necessarily involve factual matters best left  
for the jury.

1 would not allow such an outcome:

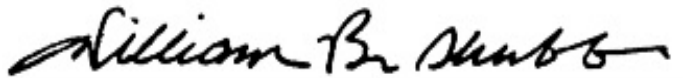
2 [Courts of equity] apply the maxim requiring  
3 clean hands only where some unconscionable  
4 act of one coming for relief has immediate  
5 and necessary relation to the equity that he  
6 seeks in respect of the matter in litigation.  
7 They do not close their doors because of  
8 plaintiff's misconduct, whatever its  
character, that has no relation to anything  
involved in the suit, but only for such  
violations of conscience as in some measure  
affect the equitable relations between the  
parties in respect of something brought  
before the court for adjudication.

9 Keystone Driller v. Gen. Excavator Co., 290 U.S. 240, 245 (1933)  
10 (internal citation omitted) (emphasis added).

11 For all of the reasons discussed above, this court  
12 cannot determine before trial that the information in defendants'  
13 two engineering notebooks and in Amr Mohsen's testimony about  
14 those notebooks was immaterial as a matter of law.

15 IT IS THEREFORE ORDERED that defendants' motion to  
16 dismiss Counts One and Nineteen and defendant Amr Mohsen's motion  
17 to dismiss Counts Two through Four and Ten through Eighteen of  
18 the Superseding Indictment be, and the same hereby are, DENIED.

19 DATED: December 2, 2005

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22 WILLIAM B. SHUBB  
23 UNITED STATES DISTRICT JUDGE  
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